Vulcan Golf, LLC v. Google Inc. et al Doc. 217

IN THE UNITED STATES DISTRICT COURT
FOR THE NORTHERN DISTRICT OF ILLINOIS
EASTERN DIVISION

VULCAN GOLF, LLC, JOHN B. SANFILIPPO & SON, INC., BLITZ REALTYGROUP, INC., and VINCENT E. "BO" JACKSON, Individually and on Behalf of All Others Similarly Situated,	§	Civil Action No. 07 CV 3371
Lead Plaintiffs,	§	Honorable Blanche M. Manning
v.	§	
GOOGLE INC., OVERSEE.NET, SEDO LLC, DOTSTER, INC., AKA REVENUEDIRECT.COM, INTERNET REIT, INC. d/b/a IREIT, INC., and JOHN DOES I-X,	§	
Defendants.	§	

PLAINTIFFS' REPLY IN SUPPORT OF MOTION FOR CLASS CERTIFICATION

Dockets.Justia.com

Table of Contents

Preliminary Statement 1

I. Plaintiffs' ACPA Claim is not a Traditional Infringement Claim and should be Certified 1

A. "Confusingly Similar" vs. "Likelihood of Confusion" 1

B. The Simonson Declaration 2

II. The Proposed Class Is Objectively Ascertainable 3

A. The Originally Proposed Class 3

B. The Doubly-Registered Subclass 3

III. The Proposed Class is Manageable 6

IV. Common Issues Predominate 7

A. Distinctiveness or Famousness can be Litigated on a Class-wide Basis 7

B. There are no Individual Issues Involved in Determining whether Domain Names are Confusingly Similar 9

1. Pre-pending "www" or "http" or post-pending "com" 9

2. Changing a single character or adding a Dictionary word 10

C. Any Individual issues relating to trademark ownership will not defeat class certification 10

D. Claims for Violations of the ACPA for the Improper Use of Personal Names can also be Resolved on a Class-wide Basic 11

E. Plaintiffs do not Assert Claims Under the "Dilution" Test Of the ACPA 11

F. Affirmative Defenses do not Preclude Class Certifications 12

V. Plaintiffs' Unjust Enrichment Claim should be Certified 12

	A.	**California Law Should Be Applied to Plaintiffs' Unjust Enrichment Claims**	12
	B.	**Applying California Law To Plaintiffs' Unjust Enrichment Claims Is Constitutional**	13
	C.	**Conflict of Laws Analysis Favors The Application of California Law to Plaintiffs' Unjust Enrichment Claims**	14
	D.	**Even if the Laws of the Fifty States Applied, Certification Of Plaintiffs' Unjust Enrichment Claim is Appropriate**	15
		1. The Elements of Unjust Enrichment Are Similar Across the Country	16
VI.	**A Class Action is the Superior Method for Resolving This Litigation**		17
VII.	***Napster* and the other Copyright Class Action cases cited by Plaintiffs Support Class Certification**		19
VIII.	**Class Treatment Is Appropriate Under Multiple Subsections of Rule 23 (b)**		21
	A.	**Class Treatment is Proper Under Rule 23 (b)(2) Because The Primary Relief Requested is Equitable in Nature**	22
	B.	**Class Treatment is Proper Under Rule 23 (b) (1)**	22
IX.	**Class Treatment is Proper Under Rule 23 (a)**		22
	A.	**The Named Plaintiffs are Adequate Class Representatives And Do Not have Conflicts with the Class they seek to Represent**	22
	B.	**The Named Plaintiffs are Typical Class Representatives**	24
V.	**Conclusion**		25

Table of Authorities

Cases

Allison v. Citgo Petroleum Corp., 151 F.3d 402 (5th Cir. 1998).. 22

Arthur Rutenberg Homes, Inc. v. Nobles, 2008 WL 2571861 (M.D. Fla. 2008).................. 21

Avery v. State Farm Mut. Auto. Ins. Co., 746 N.E.2d 1242 (Ill. App. 2001)........................ 14

Avlon Industries v. Robinson, 2005 WL 331561 (N.D. Ill. 2005).. 8

Baltimore Orioles v. Major League Baseball Players Ass'n., 805 F.2d 663 (7th Cir. 1986). 14

Boyes v. Greenwich Boat Works, Inc., 27 F. Supp.2d 543 (D.N.J. 1998)............................ 16

Castano v. Am. Tobacco Co., 84 F.3d 734 (5th Cir. 1996).. 19

Chamberlan v. Ford Motor Co., 402 F.3d 952 (9th Cir.2005)... 7

Coca-Cola Co. v. Purdy, 382 F.3d 774 (8th Cir. 2004).. 2

Contact Buyers League v. F. & F. Investment, 300 F. Supp. 210 (N. D. Ill. 1969)............. 24-25

Cox v. Joe Rizza Ford, Inc., 1996 WL 65994 (N.D. Ill. 1996)... 17

DISC Intellectual Properties LLC v. Delman, 2007 WL 4973849 (C.D. Cal. 2007)........... 2

Dunn v. City of Chicago, 231 F.R.D. 367 (N.D. Ill. 2005).. 12

Emilio Pucci Societa a Responsibilita Limitata v. Pucci Corp.,
10 U.S.P.Q.2d 1541 (N.D. Ill. 1988).. 11

Esser v. McIntyre, 661 N.E.2d 1138 (Ill. 1996).. 14, 15

Factory Mutual Ins. Co. v. Bobst Group, 2004 WL 757061 (N.D. Ill. 2004)...................... 19

Feder v. Electronic Data Systems Corp., 429 F.3d 125 (5th Cir. 2005)............................... 7

Freeland v. AT & T Corp, 238 F.R.D. 130 (S.D.N.Y. 2006).. 23

Garner v. Healy, 184 F.R.D. 598 (N.D. Ill. 1999).. 14

Gates v. Towery, 2004 WL 2583905 (N.D. Ill. 2004)... 4

Gordon v Boden, 586 N.E.2d 461 (Ill. App. Ct. 1991 14

Gruber v. Price Waterhouse, 117 F.R.D. 75 (E.D. Pa. 1987) 14, 17

Hamil America v. GFI, 193 F.3d 92, 100 (2d Cir. 1999).. 21

Hammond v. Air Line Pilots Ass'n, 1988 WL 121595 (N.D. Ill. 1988) 4

Harris v. General Dev. Corp., 127 F.R.D. 655 (N.D. Ill. 1989)... 4

Hill v. Galaxy Telecom., L.P., 184 F.R.D. 82 (N.D. Miss. 1999)... 16

In re Abbott Labs. Norvir Antitrust Litig., 2007 WL 1689899 (N.D. Cal. 2007) 15

In re Activision Securities Sec. Litig., 1985 WL 5827 (N.D. Cal. 1985).............................. 13

In re Domestic Air Transp. Antitrust Litig., 137 F.R.D. 677 (N.D. Ga. 1991)..................... 4

In re Honeywell Intern. Inc. Securities Litig., 211 F.R.D. 255 (D.N.J. 2002 24

In re LILCO Sec. Litig., 111 F.R.D. 663 (E.D.N.Y. 1986) 13

In re Napster Copyright Lit., 2005 WL 1287611 (N.D. Cal. 2005) 10, 18, 19, 20, 21

In re ORFA Sec. Litig., 654 F. Supp. 1449, 1462-63 (D.N.J. 1987).................................... 13

In re Rhone-Poulenc Rorer Inc., 51 F.3d 1293 (7th Cir. 1995).. 18-19

In re Sears Roebuck & Co. Tools, Marketing & Sales Practices Litig., 2006 WL 3754823 (N.D. Ill. 2006) 14

In re Warfarin Sodium Antitrust Litig., 2002 WL 2007850 (D. Del. 2002) 13

King v. Wright, 1995 WL 579546 (N.D. Ill. 1995)... 4

Kingvision Pay Per View v. Boom Town Saloon, 98 F. Supp. 2d 958 (N.D. Ill. 2000)......... 19

Lobo Exploration Co. v. Amoco Prod. Co., 991 P.2d 1048 (Okla. Civ. App. 1999)............ 13, 14

Little Caesar Enterprises, Inc. v. Smith, 172 F.R.D. 236 (E.D. Mich. 1997)....................... 1

Martin v. Heinold Commodities, Inc., 510 N.E.2d 840 (Ill. 1987) 14

Mashantucket Pequot Tribe v. Redican, 403 F. Supp. 2d 184 (D. Conn. 2005)................... 10

Matter of Colorado Springs Air Crash, 867 F. Supp. 630 (N.D. Ill. 1994).......................... 13

Merk v. Jewel Food Stores Div., 702 F. Supp. 1391 (N.D. Ill. 1988).................................. 12

Murry v. America's Mortg. Banc, Inc. 2006 WL 1647531 (N.D. Ill. 2006)......................... 7

Murray v. GMAC Mortgage Corp., 434 F.3d 948 (7th Cir. 2006)...................................... 18

N. Light Tech., Inc. v. N. Lights Club, 236 F.3d 57 (1st Cir. 2001)..................................... 2

Navigation Catalyst Systems, Inc., 2008 WL 2651163 (C.D. Cal. 2008)............................ 10

Omega S.A. v. Omega Engineering, Inc., 228 F. Supp. 2d 112 (D. Conn. 2002)................. 3, 10

Panache Broadcasting of Pennsylvania, Inc. v. Richardson Electronics, Ltd.,
1999 WL 342392 (N.D. Ill. May 14, 1999).. 1

Phillips Petroleum Co. v. Shutts, 472 U.S. 797 (1985)... 13, 14

Pinkett v. Moolah Loan Corp., 1999 WL 1080596 (N.D. Ill. 1999).................................... 12

Portis v. City of Chicago, 2003 WL 22078279 (N.D. Ill. 2003).. 12

Powers v. Lycoming Engines, 245 F.R.D. 226 (E.D. Pa. 2007)... 16

Purcell and Wardrope Chartered v. Hertz Corp., 530 N.E.2d 994 (Ill. App. Ct. 1988)....... 13-14

Regents of University of California v. Credit Suisse First Boston (USA), Inc.,
482 F.3d 372 (5th Cir. 2007).. 7

Rota v. Brotherhood of Railway, Airline and Steamship Clerks,
64 F.R.D. 699 (N.D. Ill. 1974)... 4-5

Ryan v. Carl Corp., 1999 WL 16320 (N.D. Cal. 1999)... 20, 21

Sanders v. Lincoln Service Corp., 1993 WL 211358 (N.D. Ill. 1993)................................ 13

Scholes v. Moore, 150 F.R.D. 133 (N.D. Ill. 1993).. 12

Shields v. Zuccarini, 254 F.3d 476, 484 (3d Cir. 2001)... 3

Singer v. AT&T Corp., 185 F.R.D. 681 (S.D. Fla. 1998).. 16

TCPIP Holding Co. v. Haar Communications Inc., 2004 WL 1620950 (S.D.N.Y. 2004).. 10

Tiffany (NJ) Inc. v. eBay, 2008 WL 2755787 (S.D.N.Y. 2008) 18

Tristar Pictures, Inc. v. Del Taco, 1999 WL 33260839 (C.D. Cal. 1999) 19

Walsh v. Chittenden Corp., 798 F. Supp. 1043 (D. Vt. 1992) 24

Weiss v. Winners Circle, 1995 WL 755328 (N.D. Ill. 1995) 24

Weld v. Glaxo Wellcome Inc., 746 N.E.2d 522 (Mass. 2001) 25

Zeno v. Ford Motor Co., Inc., 238 F.R.D. 173 (W.D. Pa. 2006) 7

Statutes

15 U.S.C.A. § 1115 6

15 U.S.C. § 1125(d)(1)(A) 3, 11

15 U.S.C § 1125(d)(1)(B)(i)(II) 12

15 U.S.C. § 1125(d)(1)(B)(i)(VIII) 6

Restatements

Restatement (Third) of Restitution & Unjust Enrichment, § 1 16

PRELIMINARY STATEMENT

"The gestalt of much of defendants' argument is an attempt to make this case appear overwhelmingly complicated and thereby remove the class action tool from plaintiffs' hands." *Little Caesar Enterprises, Inc. v. Smith,* 172 F.R.D. 236, 246 (E.D. Mich. 1997). Like the court in *Little Caesar*, this Court "believe[s] defendants' complexity arguments are exaggerated, should not intimidate or overwhelm this Court, and should not prevail." *Id.*

Panache Broadcasting of Pennsylvania, Inc. v. Richardson Electronics, Ltd., 1999 WL 342392 at *7 (N.D.Ill. 1999).

In their opening brief, Plaintiffs provide a workable class definition and methodology for ascertaining membership in that class. In response, Defendants miscast Plaintiffs' claims, misrepresent that a detailed trial plan is required and trump up a slew of claimed material individual issues, despite established law holding that those individual issues (such as affirmative defenses) do not defeat class certification. Defendants' efforts to end this case by removing the class action tool from Plaintiffs' hands must fail.

ARGUMENT

I. Plaintiffs' ACPA Claim is not a Traditional Infringement Claim and Should be Certified

Defendants ignore entirely the distinctions between an ACPA claim and a traditional trademark infringement claim and argue as though Plaintiffs are seeking certification of traditional trademark infringement claims. Nothing could be further from the truth.

A. "Confusingly Similar" vs. "Likelihood of Confusion"

Chief among the distinctions between an ACPA claim and a traditional trademark infringement claim is the difference between the "confusingly similar" standard under the ACPA and the "likelihood of consumer confusion" standard that governs traditional trademark infringement claims. As Defendants point out throughout their brief, the "likelihood of confusion" test involves a multi-step analysis that includes such factors as the "area and manner of concurrent use" and "whether actual confusion exists." Defendants ignore, however, that this test is *not* applicable to ACPA claims.

In sharp contrast, the ACPA's "confusingly similar" standard requires only a facial comparison of the mark and the domain name. *See, e.g., DISC Intellectual Properties LLC v. Delman*, 2007 WL 4973849, 5 (C.D. Cal. September 17, 2007) ("the ACPA requires only facial comparison of the domain name to the mark rather than the more involved likelihood of confusion analysis."); *see also Coca-Cola Co. v. Purdy,* 382 F.3d 774, 783 (8th Cir. 2004) ("The inquiry under the ACPA is thus narrower than the traditional multifactor likelihood of confusion test for trademark infringement."); *N. Light Tech., Inc. v. N. Lights Club,* 236 F.3d 57, 66 n. 14 (1st Cir. 2001) ("[T]he 'likelihood of confusion' test of trademark infringement is 'more comprehensive' than the 'identical or confusingly similar' requirement of ACPA, as it requires considering factors beyond the facial similarity of the two marks.")

B. The Simonson Declaration

The Declaration of Itamar Simonson is not relevant to whether Plaintiffs' ACPA claims should be certified. Simonson focuses exclusively on the "likelihood of consumer confusion" standard, opining on the various factors considered in assessing "likelihood of confusion" and on the use of consumer surveys, which are often employed to estimate "likelihood of confusion." *See, e.g.,* Simonson Dec. at ¶¶ 12, 19, 30-35. As such, he concludes that "members of the proposed class have very little in common with respect to the factors that determine likelihood of confusion." Simonson Dec. at ¶ 39.

In contrast, the standard for determining whether a domain name is "confusingly similar" is quite simple. The "conduct covered by the phrase 'confusingly similar' is the intentional registration of domain names that are misspellings of distinctive or famous names, causing an

Internet user who makes a slight spelling or typing error to reach an unintended site." *Shields v. Zuccarini*, 254 F.3d 476, 484 (3d Cir. 2001). Courts make this determination by doing a facial comparison between the domain in question and the mark in question. *See also Omega S.A. v. Omega Engineering, Inc.,* 228 F. Supp. 2d 112, 126-27 (D. Conn. 2002) (ACPA "directs that whether a domain name is confusingly similar to a trademark is to be evaluated 'without regard to the goods or services of the parties'"); 15 U.S.C. § 1125(d)(1)(A).

II. The Proposed Class Is Objectively Ascertainable

A. The Originally Proposed Class

Contrary to Defendants' arguments, the proposed class does not contain all mark owners or all individuals in the United States – nor does identifying class members require merits determinations. As Plaintiffs make clear, the class consists of those mark owners and individuals whose names and marks Defendants have appropriated by parking domains with specific, identifiable variations on the names and marks, such as pre-pending "www" or "http," post-pending "com," or changing one letter. In the section of their brief addressing ascertainability, Defendants ignore entirely Plaintiffs' proposed methodology for ascertaining the class (which, of course, is derived from Google's own arguments in prosecuting domain disputes). To the extent that Defendants quarrel with the methodology because it is not expressly included in the language of the class definition, that concern is easily remedied: The ascertainment methodology set forth elsewhere in Plaintiffs' brief can be moved directly into the class definition itself.

B. The Doubly-Registered Subclass

In response to Defendants' stated concerns, Plaintiffs have moved the ascertainment methodology into the definition of a subclass including: (1) only those mark owners that have registered their marks as domains; and (2) only the simplest and most straightforward steps from the ascertainment methodology set forth in Plaintiffs' opening brief:

> Any owner of a mark appearing on the principal or secondary registry of the United States Patent and Trademark Office who has registered a domain name containing that mark (a "mark owner's domain name"), and whose "mark owner's domain name" differs from a domain name parked and advertised on by one or more of the Defendants only by addition of a pre-pending "www" or "http" or post-pending "com."

While the class defined in Plaintiffs' opening brief is certifiable for the reasons set forth in that brief and herein, the above subclass (the "doubly-registered subclass") includes only those mark owners that have registered their marks *both as marks* (with the PTO) *and as domain names* (with an ICANN registrar), and therefore meets all of the challenges raised by Defendants.[1]

As noted in Plaintiffs' opening brief, the class must be adequately defined and clearly ascertainable. *Harris v. General Dev. Corp.,* 127 F.R.D. 655, 658 (N.D. Ill. 1989). In *Harris,* the court initially found that identification of class members would entail individual adjudications and that the class definition was imprecise and speculative. Rather than denying class certification, the court, instead, redefined the class.

Moreover, a class may be certified even though the initial definition includes members who have not been injured or do not wish to pursue claims against the defendant. *Rota v.*

[1] Modifying the class definition in the reply brief, in response to defense arguments, is a common and appropriate practice. *See, e.g., Gates v. Towery*, 2004 WL 2583905, *1 (N.D. Ill. Nov. 10, 2004) (certifying class after plaintiffs "revise[d] their initially proposed class definition" in their "reply brief"); *King v. Wright*, 1995 WL 579546, *2 (N.D. Ill. Sept. 30, 1995) (certifying class after "[p]laintiffs. . . in their reply memorandum [proposed] the following modified class definition"); *Hammond v. Air Line Pilots Ass'n*, 1988 WL 121595, *5 (N.D. Ill. Nov. 8, 1988) (certifying class where "[i]n their reply brief, plaintiffs revised their proposed class definition"). *See also In re Domestic Air Transp. Antitrust Litig.,* 137 F.R.D. 677, 683 (N.D. Ga. 1991) ("The act of refining a class definition is a natural outcome of federal class action practice. Rule 23 requires that the motion for class certification be presented to the Court at the earliest practicable date. As a result, a plaintiff's original class definition is often framed on the basis of little, if any, discovery, to be opposed by defendants who have a wealth of information concerning the industry.").

Brotherhood of Railway, Airline and Steamship Clerks, 64 F.R.D. 699, 706 (N.D. Ill. 1974). Once discovery is permitted to proceed and Defendants provide a list of all of the domain names they have parked, it will be a relatively simple matter to generate a list of all members of the doubly-registered subclass:

1. Compare a list of all registered word trademarks (easily accessible through the TESS system made available by the United States Patent and Trademark Office) to a list of all registered domain names (available from domain registrars or through websites such as www.whois.net) and *identify those mark owners that have registered domains that contain their marks* ("mark owner's domains").[2]

2. Compare the list of "mark owner's domains" to the list of all domains parked by Defendants and *identify those parked domains that differ from a mark owner's domain by only a pre-pended "http" or "www," or a post-pended "com."*

3. Reduce the list of mark owners generated in Step 1 to only those whose "mark owner's domains" have a corresponding typosquatting domain in the list generated by Step 2.

---

[2] This process would, for example, identify Plaintiffs Vulcan Golf, LLC ("Vulcan") and John B. SanFilippo & Son, Inc. ("SanFilippo"). Vulcan has registered its mark "vulcan" and also registered the domain "vulcangolf.com," which contains its mark. SanFilippo has registered its mark "fisher" and also registered the domain "fishernuts.com," which contains its mark. *See* TESS and "whois" search results (attached hereto as Exhibit 1). To the extent that any irregularities in trademark registration or domain registration prevent automated matching, a claim form or other claim procedure will allow class members to provide supplemental information to confirm their membership in the class. Also, as is well known to Defendants, many domain names are registered through third-party service providers on behalf of the mark owner. Discovery directed to such third parties may be necessary to identify those class members.

This administrative process, which can only be conducted once all Defendants provide their full current and historical lists of parked domains, does not require any individual inquiry or merits determinations by the Court.

III. The Proposed Class is Manageable

Defendants' manageability arguments are easily answered. Because the doubly-registered subclass is limited to owners of registered trademarks who have registered their marks as (or within) domain names, issues of ownership and distinctiveness are subject to *prima facie* proof through systematic class-wide methodologies.

Ownership and current validity of a trademark are matters easily ascertained through the TESS system of the United States Patent and Trademark Office. Once ownership and current validity of the mark are shown there is a presumption of distinctiveness. 15 U.S.C.A. § 1115. Determining whether one of Defendants' parked domains is "confusingly similar" to a mark is no more complicated than making a facial comparison of the class member's registered domain name to the Defendants' parked domains.

Defendants do not seriously contest Plaintiffs' ability to prove the "bad faith" element of their ACPA claim on a class-wide basis (indeed, they list it in their charts but fail to discuss it). Indeed, Defendants' bad faith intent can easily be shown on a class-wide basis. The ACPA provides a list of statutory factors that may be used to determine "bad faith intent," and those factors are tailor-made for this group of Defendants. For example, one factor evidencing bad faith intent is the "registration or acquisition of multiple domain names which the [defendant)] knows are identical or confusingly similar to marks of others." 15 U.S.C. § 1125 (d)(1)(B)(i)(VIII).

It is well-settled that Plaintiffs are not required to prove the merits of their case or provide a detailed trial plan at the class certification stage.[3] Notwithstanding this clear authority, it is already evident here that Defendants have systematically typosquatted others' protected marks on an unprecedented scale using Google's "semantic technology" and Google's ability to acquire, store, manipulate and search data on an unprecedented scale, and that class treatment is therefore appropriate. Plaintiffs respectfully suggest that once a class has been certified and Google is subjected to discovery, the simplicity and ease of managing this case as a class action will become even clearer and more evident.

IV. Common Issues Predominate

The majority of the claimed individual issues conjured up by Defendants are either inapplicable or may arise only with respect to affirmative defenses. Contrary to their suggestions, no discovery from individual mark owners will be required.

A. Distinctiveness or Famousness can be Litigated on a Class-wide Basis

---

[3] Defendants suggest that a trial plan is a necessary prerequisite to class certification. This is not the law and none of the cases cited by Defendants so hold. There is no authority for this requirement in the Seventh Circuit and courts that have considered the issue have rejected this approach. *See, e.g., Regents of University of California v. Credit Suisse First Boston (USA), Inc.*, 482 F.3d 372 (5th Cir. 2007) (trial plan submitted one month post certification); *Feder v. Electronic Data Systems Corp.,* 429 F.3d 125 (5th Cir. 2005) (trial plan not required to prove superiority of class treatment); *Chamberlan v. Ford Motor Co.,* 402 F.3d 952, 961 n. 4 (9th Cir.2005) (per curium), (the Ninth Circuit "decline[d] Ford's "suggestion that the district court's failure to adopt a trial plan or to articulate how the class action would be tried was an abuse of discretion ... [since] [n]othing in the Advisory Committee Notes suggests grafting a requirement for a trial plan onto the rule."); *Zeno v. Ford Motor Co., Inc.*, 238 F.R.D. 173 (W.D. Pa. 2006) (granting class certification even though plaintiff failed to submit trial plan which had been specifically requested by the court); *Murry v. America's Mortg. Banc, Inc.* 2006 WL 1647531 (N.D. Ill. 2006) ("Defendants first argue that the motion for class certification must be denied because plaintiffs have failed to present a trial plan. However, defendants fail to cite any controlling authority for that proposition."). Certainly, if and when this Court requests Plaintiffs to submit a trial plan they will comply. However, Rule 23 does not require a trial plan, nor does it comport with common sense to require one prior to discovery, if ever.

Defendants concede, as they must, that marks registered on the PTO's Principal Register are presumed distinctive. (Def. Brief at 13.) Defendants go on to point out that marks registered on the Supplemental Register are presumed not to be distinctive, but ignore the fact that this Court's ruling on distinctiveness in *Avlon Industries v. Robinson*, 2005 WL 331561 (N.D. Ill. February 8, 2005) (Manning, J.) is logically applicable to all registered marks, whether registered on the Principal Register or the Supplemental Register.[4]

In *Avlon*, this Court held that certain marks were distinctive where the defendant had registered several domain names containing multiple variations of the plaintiff's mark:

> *With respect to the degree of the KeraCare mark's distinctiveness,* Robinson contends that only the "upscale African-American women's marketplace" is aware of the marks and that they are otherwise not well known. Robinson, however, is using numerous variants of the KeraCare marks to lure customers to his website. He has also conceded that people searching on the Internet for the word "KeraCare" would be only looking for Avlon's KeraCare products. *As the saying goes, actions speak louder than words. If the marks were indeed unfamiliar to the vast majority of shoppers, Robinson would not have registered at least fifteen variants of the word KeraCare as domain names in connection with his website.*

Avlon Industries, 2005 WL 331561 at *2. Nothing in the *Avlon* decision suggests that this distinctiveness holding would be limited to marks on the Principal Register, or even to registered marks. The Court saw that "the proof is in the pudding," *i.e.*, that registration of multiple domains containing the mark or misspellings of the mark indicate that a mark is distinctive.

---

[4] Defendants incorrectly argue that "in *Avlon,* the distinctiveness of the marks was not at issue, only their fame." (Def. Brief at 15.) If that were so, the Court would not have engaged in the distinctiveness analysis set forth above. Instead, it is clear that the defendant, Robinson, attempted to rebut the presumption of distinctiveness (*i.e.,* arguing that only a limited group was aware of the mark), but that the multiple registrations were strong enough evidence of distinctiveness to overcome his challenge. Indeed, this Court's only mention of a presumption came after already concluding – on the basis of the multiple domain registrations – that the plaintiff's mark was distinctive. *Avlon* at *2. Further, the presumption mentioned by the Court in connection with its famousness analysis was not the presumption of distinctiveness that attaches to a mark immediately upon inclusion in the Principal Register, but rather a more general presumption of validity and protectability that attaches after a mark becomes uncontestable. *Id.*

Also, the *Avlon* holding can and should be extended to famousness. Where a cybersquatter registers and profits from multiple domain names that are identical or confusingly similar to a registered mark, it is clear that the mark is either distinctive or famous, or both.

In sum, distinctiveness will be easy and manageable to litigate on a classwide basis. Not only are all marks on the Principal Register entitled to a presumption of distinctiveness, but defendants have provided no reason to believe that they will have any basis to even attempt to rebut that presumption under any circumstance. Even where Defendants might attempt to rebut the presumption, Defendants' multiple registrations of confusingly similar domains will be ample evidence to overcome their challenge. In any event, determinations will be made either strictly by presumption, or where Defendants attempt to rebut the presumption, by application of a computerized search through Defendants' records. The Court will not be required to make any individualized determinations.

B. There are no Individual Issues Involved in Determining Whether Domain Names are Confusingly Similar.

All the examples that Defendants use to attack Plaintiffs' proposed methodology for determining "confusingly similar" domain names on a class-wide basis are either fundamentally flawed or irrelevant to the doubly-registered subclass:

1. **Pre-pending "www" or "http" or post-pending "com".** Defendants manage to find a few examples where these pre-pends and post-pends are used in content-based sites that are not confusingly similar to the corresponding marks. (See Def. Brief at 17-19: "www2008.com," "httpwatch.com" "httpguru.com," "telecom.com" and "bearcom.com".) But each of these examples fails for the same reason: these are content-based sites, not Defendants' parked advertising-only sites. Thus, these domains are not included in the class definition (either with respect to the full, originally proposed class or the doubly-registered subclass), and these "examples" are wholly irrelevant to this class certification motion. The same will be true for any other example of this type that Defendants may manage to locate.

2. **Changing a single character or adding a dictionary word**. There is strong case law to support inclusion of these categories.[5] However, because Plaintiffs recognize that these categories of cybersquatting may require more creative and proactive management than the simpler ACPA violations described above, Plaintiffs have removed this and the related categories (e.g., adding a controversial or objectionable word; combining a typographical error with the addition of a word, etc.) from the doubly-registered subclass. Treatment of these infringements may be appropriate at some later date.

Thus, it is feasible and manageable to apply objective criteria that will consistently identify confusingly similar domain names. Defendant's attempt to show that class certification is inappropriate on this basis must therefore fail.

C. Any individual issues relating to trademark ownership will not defeat class certification.

As noted, ownership and current validity of a trademark are matters easily determined through the TESS system of the United States Patent and Trademark Office. Defendants provide no reason to believe that they will have grounds to challenge ownership on any significant number of marks. Indeed, this very argument has already been rejected in similar class certification disputes. *See, e.g., In re Napster Copyright Litigation*, 2005 WL 1287611 at *7

---

[5] *See, e.g., Mashantucket Pequot Tribe v. Redican*, 403 F. Supp. 2d 184, 195-96 (D. Conn. 2005) ("'[F]oxwood" and 'foxwoods' differ by only one letter, the final 's.' The court concludes that Redican's foxwood.com site is confusingly similar to Mashantucket's foxwoods.com site."); *TCPIP Holding Co. v. Haar Communications Inc.*, 2004 WL 1620950, *5 (S.D.N.Y. 2004) (at least eighty domain names found to be confusingly similar where "the domain names add[ed] or omit[ted] one or two letters of Plaintiff's registered mark"); *Verizon California Inc. v. Navigation Catalyst Systems, Inc.*, __ F.Supp.2d __, 2008 WL 2651163, *5 (C.D. Cal. 2008) (finding confusing similarity where "ve3rizon.com and veri8zon.net" both "consist[ed] of Plaintiffs' actual domain names, including Plaintiffs' trademarks, plus one extra character – in both cases a character located on the computer keyboard next to a letter found in the correct domain name"); *Omega S.A. v. Omega Engineering, Inc.,* 228 F. Supp. 2d 112, 127-28 (D. Conn. 2002) ("the 'confusingly similar' analysis can be applied to domain names consisting of another's mark coupled with a generic word or term").

(N.D.Cal. 2005) ([W]hile it is true that proof of ownership . . . ultimately requires a work-by-work inquiry, viewing these determinations as purely 'individual issues' ignores the fact that the claims of every member of the class are uniformly premised upon the uploading or downloading of a copyrighted work by Napster users.").

D. Claims for Violations of the ACPA for the Improper Use of Personal Names can also be Resolved on a Class-wide Basis.

Defendants claim that personal names must have "acquired distinctiveness and secondary meaning" before they can be protected. (Def. Brief at 20.) However, the only support they can muster for that proposition is a traditional trademark infringement case decided before the ACPA was even enacted.[6] *See Emilio Pucci Societa a Responsibilita Limitata v. Pucci Corp.*, 10 U.S.P.Q.2d 1541 (N.D. Ill. 1988). The fact is that the plain language of the ACPA demonstrates an intent to protect all personal names. *See* 15 U.S.C. § 1125(d)(1)(A) ("a personal name . . . is protected as a mark under this section"); 15 U.S.C § 1125(d)(1)(B)(i)(II) (court may consider "extent to which the domain name consists of the legal name of a person or a name that is otherwise commonly used to identify that person").

E. Plaintiffs do not Assert Claims Under the "Dilution" Test of the ACPA.

Defendants raise the false specter of yet more individual issues by arguing that they will arise "to the extent any class member attempts to prove . . . that a particular domain name is 'dilutive of' a 'famous mark.'" (Def. Brief at 21). But Plaintiffs' class clearly implicates only the "confusingly similar" test of the ACPA. *See* 15 U.S.C § 1125(d)(1)(A)(ii)(I) and (II). Whether a mark has been diluted will never need resolution, so the purported "individual issues" raised by the "dilutive of" test represent yet another transparent defense attempt to raise individual issues where none exist.

---

[6] As noted in Plaintiffs' opening brief, Congress passed the ACPA in 1999.

F. Affirmative Defenses do not Preclude Class Certification.

According to Defendants, class certification should be denied because Defendants have pled a number of affirmative defenses, such as fraudulent registration, abandonment, and fair use – each of which, Defendants claim, will require individual determinations. (Def. Brief at 22 and charts at 11). Once again, Defendants are wrong. Indeed, Defendants do not provide even a single example to support their argument. In any event, the law is clear that affirmative defenses that may apply to some class members do not defeat class certification. Otherwise, any defendant could defeat class certification simply by pleading affirmative defenses and then pointing to the various possible individual issues that might hypothetically arise. Thus, "the existence of individualized defenses does not preclude class certification." *Dunn v. City of Chicago*, 231 F.R.D. 367, 375-76 (N.D. Ill. 2005). *See also Portis v. City of Chicago*, 2003 WL 22078279, *3 (N.D. Ill. 2003) ("Individual affirmative defenses do not preclude class treatment."); *Pinkett v. Moolah Loan Corp.*, 1999 WL 1080596, at *4 (N.D. Ill. 1999) ("[I]t is well established that individual counterclaims or defenses do not render a case unsuitable for class certification."); *Merk v. Jewel Food Stores Div.*, 702 F. Supp. 1391, 1395 (N.D. Ill. 1988) ("The existence of affirmative defenses as to some class members is not by itself enough to warrant the denial of certification."). Accordingly, class certification should not be denied on this basis.

V. Plaintiffs' Unjust Enrichment Claim should be Certified.

Defendants argue that state variations regarding the law of unjust enrichment preclude class certification.[7] For a number of independent reasons, Defendants are wrong.

A. California Law Should Be Applied To Plaintiffs' Unjust Enrichment Claims.

---

[7] Defendants misrepresent that that no court in this District has granted class certification of an unjust enrichment claim. *See*, *e.g.*, *Scholes v. Moore*, 150 F.R.D. 133 (N.D. Ill. 1993).

This Court may and should apply only California law to Plaintiffs' unjust enrichment claims. California's unjust enrichment law is materially the same as that of the other states and the uniform policy against unjust enrichment is furthered by applying California law. *Cf. In re Warfarin Sodium Antitrust Litig.*, 2002 WL 2007850 at *14 (D. Del. 2002); *Sanders v. Lincoln Service Corp.*, 1993 WL 211358, at *1 (N.D. Ill. 1993).

In addition, application of California unjust enrichment law would further the important goals of certainty, predictability and uniformity of result, and the protection of justified expectations. *Matter of Colorado Springs Air Crash*, 867 F. Supp. 630, 635 (N.D. Ill. 1994). Here, Defendants Google and Oversee cannot object that they could have expected a different result, since they are both headquartered in California. *Id.* In addition, given Google's role as creator, master facilitator and beneficiary of the Deceptive Domain Scheme, the other Defendants cannot credibly argue that applying California law is improper or somehow unfair.

B. Applying California Law To Plaintiffs' Unjust Enrichment Claims Is Constitutional.

Application of a single state's law to Plaintiffs' unjust enrichment claim is Constitutional.[8] *See Phillips Petroleum Co. v. Shutts*, 472 U.S. 797, 818 (1985). Accordingly, numerous courts have applied one state's laws to claims brought by nationwide or multistate classes. *See, e.g.*, *In re Activision Securities Sec. Litig.*, 1985 WL 5827 (N.D. Cal. 1985);

[8] *See, e.g., Lobo Exploration Co. v. Amoco Prod. Co.*, 991 P.2d 1048, 1053 (Okla. Civ. App. 1999), *cert. denied*, 529 U.S. 1124 (2000); *In re ORFA Sec. Litig.*, 654 F. Supp. 1449, 1462-63 (D.N.J. 1987); *In re LILCO Sec. Litig.*, 111 F.R.D. 663, 670 (E.D.N.Y. 1986).

Purcell and Wardrope Chartered v. Hertz Corp., 530 N.E.2d 994, 996 n.1 (Ill. App. 1988) (citing *Shutts*), *appeal denied by* 537 N.E.2d 818 (Ill. 1989).[9]

Here, applying California law would comport with due process because of the significant contacts between the claims of all plaintiffs and all class members and that state. Defendants Google and Oversee are headquartered in California. Given Google's primary role in the Deceptive Domain Scheme, the core of the challenged conduct and creation of the scheme occurred in California. These contacts clearly establish a sufficient nexus between California and Plaintiffs' unjust enrichment claims such that application of California law is neither arbitrary nor fundamentally unfair. *See, e.g., Avery v. State Farm Mut. Auto. Ins. Co.*, 746 N.E.2d 1242, 1254-55 (Ill. App. 2001). Application of California's unjust enrichment law is therefore constitutional. *See, e.g., Gruber v. Price Waterhouse*, 117 F.R.D. 75, 82 (E.D. Pa. 1987).

C. Conflict Of Laws Analysis Favors The Application Of California Law To Plaintiffs' Unjust Enrichment Claims.

As the forum state, the Illinois choice-of-law rules apply.[10] *Baltimore Orioles v. Major League Baseball Players Ass'n.*, 805 F.2d 663, 681 (7th Cir. 1986). Illinois follows the most significant relationship test of the Restatement (Second) of Conflicts of Law. *Esser v. McIntyre*, 661 N.E.2d 1138, 1141 (Ill. 1996).

> When applying the most significant relationship test, a court should consider: (1) where the injury occurred; (2) where the injury causing conduct occurred; (3) the

[9] *See also Lobo*, 991 P.2d at 1048); *Garner v. Healy*, 184 F.R.D. 598 (N.D. Ill. 1999); *Gordon v Boden*, 586 N.E.2d 461, 467 (Ill. App. Ct. 1991) , *appeal denied by* 591 N.E.2d 21 (Ill. 1992); *Martin v. Heinold Commodities, Inc.*, 510 N.E.2d 840 (Ill. 1987).

[10] Because Plaintiffs' unjust enrichment claim alleges that defendant procured a benefit "as a result of Defendants' deception, misconduct, and material misrepresentations involving the Distinctive and Valuable Marks of Lead Plaintiffs and the Class," TAC at ¶470, a tort choice-of-law analysis should be applied. *Cf. In re Sears Roebuck & Co. Tools, Marketing & Sales Practices Litig.*, 2006 WL 3754823, at *2 n. 4 (N.D. Ill. 2006).

> domicile of the parties; and (4) where the relationship of the parties is centered. (*Ingersoll*, 46 Ill.2d at 47, 262 N.E.2d 593.) The court must look at the contacts of the jurisdictions under these four factors and then evaluate those contacts in light of the policies underlying the laws of those jurisdictions.
>
> * * * *
>
> Section 6 of the Restatement (Second) of Conflict of Laws (1971) sets forth seven general principles to apply when making a choice-of-law decision: "(a) the needs of the interstate and international systems; (b) the relevant policies of the forum; (c) the relevant policies of other interested states and the relative interests of those states in the particular issue; (d) the protection of justified expectations; (e) the basic policies underlying the particular field of law; (f) certainty, predictability and uniformity of result; and (g) ease in the determination and application of the law to be applied."

Id. at 1141 and 1142 n.1.

Consideration of the above factors results in California law applying to Plaintiffs' unjust enrichment claims. Here, the creator, facilitator and implementer of the Deceptive Domain Scheme, Google, is headquartered in California. Google's operations are directed and controlled from California, which is also where the scheme was designed and hatched. In addition, one of the parking company defendants, Oversee, is headquartered in California. These facts strongly support the application of California law to Plaintiffs' unjust enrichment claims.

D. Even if the Laws of the Fifty States Applied, Certification of Plaintiffs' Unjust Enrichment Claim is Appropriate

> Where federal claims and common law claims are predicated on the same factual allegations and proof will be essentially the same, even if the law of the different states might ultimately govern the common law claims – an issue that need not and is not decided at this juncture – certification of the class of the whole action is appropriate. The spectre of having to apply different substantive laws does not warrant refusing to certify a class on the common law claims.

See In re Abbott Labs. Norvir Antitrust Litig., 2007 WL 1689899 at *9 (N.D. Cal. 2007). Even if this were not so, the elements necessary to establish unjust enrichment are similar from state to state. Accordingly, individual questions of law do not predominate.

1. The Elements Of Unjust Enrichment Are Similar Across The Country.

Defendants attempt to portray the unjust enrichment claim as a monster of mind-boggling complexity with laws that conflict from state to state. *See* Defs. Consol. Mem. at 22-24. In fact, to the extent that any conflicts exist, they are minor and in no way counsel against class certification.[11] *See Powers v. Lycoming Engines*, 245 F.R.D. 226, 231 (E.D. Pa. 2007) ("Although there are numerous permutations of the elements of the cause of action in the various states, there are few real differences.").

All jurisdictions recognize the basic equitable principle that "[a] person who is unjustly enriched at the expense of another is liable in restitution to the other." *Restatement (Third) of Restitution & Unjust Enrichment,* § 1 (1937).[12] The universal elements of unjust enrichment are: (1) a benefit conferred upon a defendant; (2) knowledge by the defendant of the benefit; and (3) retention of the benefit by defendant under circumstances where it would be unjust to do so without payment. *Singer v. AT&T Corp.*, 185 F.R.D. 681, 692 (S.D. Fla. 1998) (unjust enrichment is a "universally recognized cause[] of action that [is] **materially the same throughout the United States**.") (emphasis added); *see also Hill v. Galaxy Telecom., L.P.*, 184 F.R.D. 82 (N.D. Miss. 1999). Accordingly, any differences in state unjust enrichment principles

[11] A mere difference between the laws of the states at issue is not sufficient to demonstrate an "actual conflict." *Boyes v. Greenwich Boat Works, Inc.*, 27 F. Supp.2d 543, 547 (D.N.J. 1998) (citations omitted). Rather, differences between the laws must "represent competing or conflicting resolutions of a particular policy issue." *Id.* at 548.

[12] Notably, courts in at least 42 states and the District of Columbia have followed expressly, or cited with approval, the Restatement's definition of unjust enrichment. In addition, Nebraska, Virginia and Louisiana should be considered Restatement jurisdictions because the law in these states contains all the elements and language of the Restatement. *See Nationwide Survey of Unjust Enrichment* (attached hereto as Exhibit 2).

are immaterial and abundantly manageable.[13] *See Nationwide Survey of Unjust Enrichment* (attached hereto as Exhibit 2).[14]

VI. A Class Action is the Superior Method for Resolving This Litigation

Plaintiffs have shown that, based on the factors identified in *Cox v. Joe Rizza Ford, Inc.*, 1996 WL 65994, *11 (N.D. Ill. 1996), class treatment here will advance "the interests of efficiency and economy" and is the most appropriate manner to resolve Plaintiffs' claims. (Plffs' Motion at 25-27). Defendants' argument that their own procedures, arbitration proceedings and/or private individual lawsuits are more efficient methods to adjudicate plaintiffs' claims ignores the very nature of this large-scale dispute and the benefits of class action resolution itself. In particular, money damages are not available in either UDRP proceedings or under Defendants' complaint procedure. That ends any consideration of UDRP or complaint proceedings as viable alternatives to class treatment, for there is nothing "superior" about giving up a substantial right to significant money damages.

Moreover, the repetitive and identical arbitration or individual litigation of each of the class members' claims would consume enormous judicial and party resources and an unimaginable amount of time. By Defendants' own admission, an individual claim would take an average of 50 days to resolve using their suggested method, *i.e.,* the UDRP proceedings. (Def. Br. at 26). Applying Defendants' method, and even assuming that 100 proceedings may move forward simultaneously without interruption on parallel tracks, adjudicating these disputes would require hundreds of years. In marked contrast, the class action mechanism is ideally suited to resolve matters of this kind. As the court in *Napster* recognized: "the case management problems that may arise upon certification of the class must be compared to the alternative method of adjudicating the parties' claims: that is, thousands of actions by individual class members." *Napster*, 2005 WL 1287611, *9.

---

[13] *See Gruber v. Price Waterhouse*, 117 F.R.D. 75, 82 (E.D. Pa. 1987) ("[A]ny state would prefer to see a class action proceed rather than for there to be no action at all.").

[14] Some states (Florida, Maine, Rhode Island, South Carolina, South Dakota and Tennessee) require a showing of all of the Restatement elements, plus the additional element of "appreciation," "acceptance" or knowledge of the benefit on the part of the defendant. In such jurisdictions, a subclass could be created.

The decision in *Tiffany (NJ) Inc. v. eBay*, 2008 WL 2755787 (S.D.N.Y. 2008), upon which Defendants nearly exclusively rely, did not involve a motion for class certification and, indeed, never even mentioned class action litigation. In that case, the court merely adjudicated one private dispute. Significantly, Defendants cite no case in which multiple individual litigations were chosen over class treatment in a dispute similar to the present proceeding.

Defendants also argue, without support, that the statutory damages under the ACPA are an incentive for individual class members to file separate actions. (Def. Br. at 26.) Defendants ignore the realities facing individual class members. "Even with the incentives to bring such claims that the [statute] provides in the form of statutory damages and attorneys' fees [citation omitted], it nonetheless remains true that many [absent class members] individually lack the time, resources, and legal sophistication to enforce their [intellectual property rights]." *Napster*, 2005 WL 1287611 at *10. "[P]laintiffs' prospects for class certification should not suffer because [the statute] provides for statutory damages." *Id.*; *see also Murray v. GMAC Mortgage Corp.*, 434 F.3d 948 (7th Cir. 2006) (Seventh Circuit held that class certification should not be denied because statutory damages were available).

Defendants have also failed to show how this action could "destroy defendants' businesses and the entire domain-development industry." (Def. Brief at 27.) Defendants' unsupported assertions should not suffice. Moreover, the cases relied on by Defendants do not support Defendants' contentions. In *In re Rhone-Poulenc Rorer Inc.*, 51 F.3d 1293 (7th Cir.

1995), the plaintiffs sought to have a jury determine "the negligence of the defendants under a legal standard that does not actually exist anywhere in the world." *Id*. at 1300. Yet even that fact alone was not enough to dissuade the court from denying certification. Ultimately, the court denied class certification because "[e]ach plaintiff if successful is apt to receive a judgment in the millions." *Id.* The court acknowledged that individual proceedings "would not be a feasible option if the stakes to each class member were too slight to repay the cost of suit, even though the aggregate stakes were very large and would repay the costs of a consolidated proceeding." *Id.* Similarly, *Castano v. Am. Tobacco Co.*, 84 F.3d 734 (5th Cir. 1996) was another mass tort case that involved claims which historically could not be resolved in the class context. None of those impediments to certification exist in this action.

VII. ***Napster*** **and the other Copyright Class Action cases cited by Plaintiffs Support Class Certification.**

Defendants attack Plaintiffs' reliance on *In re Napster, Inc. Copyright Litig.*, 2005 WL 1287611 (N.D. Cal. June 1, 2005)[15] and other copyright class action cases cited by Plaintiffs on the basis that there is "no overlap" between copyright and trademark law.[16] (Def. Brief at 27). However, not only are the similarities between trademark and copyright claims greater than Defendants admit, but Plaintiffs' reliance on the copyright cases is not based on any contention that copyright and trademark infringement are based on identical legal doctrines. Rather,

---

[15] Defendants' attempt to undermine the persuasive authority of *Napster* by emphasizing the decision as "unpublished" should be rejected. *See Factory Mutual Ins. Co. v. Bobst Group*, 2004 WL 757061, *2 n.1 (N.D. Ill. 2004) (unpublished opinions have the same persuasive authority as any other district court opinions); *Kingvision Pay Per View v. Boom Town Saloon*, 98 F. Supp. 2d 958, 959 n.1 (N.D. Ill. 2000) ("There is no rule in the Northern District of Illinois barring citation to opinions that are published only on Westlaw or Lexis.").

[16] *Cf. Tristar Pictures, Inc. v. Del Taco*, 1999 WL 33260839, *2 (C.D. Cal. 1999) ("While these two doctrines seem similar and may often overlap, they are neither mutually dependant nor mutually exclusive.").

Plaintiffs contend that, for purposes of analyzing the viability of certifying a class, *Napster* and other copyright cases are instructive.

The defendants in *Napster* made arguments similar to those offered by Defendants herein. The *Napster* court rejected those arguments:

> [W]hile it is true that proof of ownership, registration, and actual damages ultimately requires a work-by-work inquiry, viewing these determinations as purely "individual issues" ignores the fact that the claims of every member of the class are uniformly premised upon the uploading or downloading of a copyrighted work by Napster users. This shared factual predicate in turn gives rise to a host of common legal issues concerning Bertelsmann's involvement in the operation of the Napster network. There can be no serious dispute that these issues are sufficiently "significant" to warrant adjudication of the parties' dispute on a representative rather than individual basis, *accord Culinary/Bartender Trust Fund*, 244 F.3d at 1162, nor is there any question that considerations of judicial economy heavily favor litigating these common issues once, as part of a single class action, rather than rehashing the same questions of law and fact in each of what could likely amount to thousands of individual lawsuits. The court therefore finds that the predominance requirement of Rule 23(b)(3) has been satisfied.

Napster, 2005 WL 1287611 at *7.

Similarly, in *Ryan v. Carl Corp.*, 1999 WL 16320 (N.D. Cal. 1999), the court rejected a typicality argument similar to one advanced by Defendants herein:

> This argument neglects the fact that litigation of this case will likely center around UnCover's uniform practice of copying and selling copyrighted articles without securing the authors' permission. Because of the centrality of common issues, the issues unique to individual copyrights are reduced in importance and do not interfere with a finding of typicality.

Id.

As in *Ryan* and *Napster*, there is a "centrality of common issues" in this case – the Deceptive Domain Scheme. Because the claims of each member of the proposed Class arise from the same factual predicate; namely, that Defendants licensed, trafficked in, and used the Deceptive Domain Scheme to monetize domain names that are confusingly similar to marks owned by members of the proposed Class, class certification is appropriate and warranted.

Defendants further attempt to distinguish copyright infringement cases as involving simpler standards. (Def. Brief at 28.) Defendants are wrong. Indeed, a copyright infringement claim is more complex than an ACPA claim, because copyright claims involve detailed and fact-intensive analyses. *See Hamil America v. GFI*, 193 F.3d 92, 100 (2d Cir. 1999) ("Because the 'actual copying' prong of the infringement test requires a fact-intensive inquiry, the district court's determination as to whether the defendant actually copied the plaintiff's copyright material warrants our deference."); *Arthur Rutenberg Homes, Inc. v. Nobles*, 2008 WL 2571861 (M.D. Fla. 2008) (test of substantial similarity in copyright infringement action is necessarily fact intensive). In sum, copyright infringement cases often involve highly detailed factual inquiries and numerous affirmative defenses, yet courts have certified copyright claims for class treatment. ACPA claims, which involve no such detailed factual inquiries, are even better suited for class treatment.

Finally, Defendants contend that, in the copyright class actions that have been certified, there was no real dispute as to whether widespread unlawful copying had taken place. (Def. Brief at 28.) Here, although Defendants say that they "intend to show at trial there is no likelihood of consumer confusion," (Def. Brief at 28), again, that inquiry is irrelevant to ACPA claims. Defendants cannot seriously contend that their business practices do not result in widespread violations of the ACPA. Indeed, the very existence of their complaint procedure confirms that Defendants know that their conduct promotes the registration and monetization of domains that are confusingly similar to registered marks. The question is simply whether class treatment of their widespread scheme is appropriate. It was in *Napster, Ryan* and the other copyright infringement cases, and it is here, as well.

VIII. Class Treatment Is Appropriate Under Multiple Subsections of Rule 23(b)

A. Class Treatment is Proper Under Rule 23(b)(2) Because the Primary Relief Requested is Equitable in Nature

Incidental damages are those "that flow directly from liability to the class *as a whole* on the claims forming the basis of the injunctive or declaratory relief." *Allison v. Citgo Petroleum Corp.*, 151 F.3d 402, 415 (5th Cir. 1998) (emphasis in original). Here, the damages sought are damages that class members would automatically be entitled to through the ACPA, and would be calculated by the objective standard set by the ACPA. Therefore, the damages sought should be considered incidental, and should not stand as a bar to establishing a class under Rule 23(b)(2). Moreover, as noted at page 28 of Plaintiffs' opening brief, it is common in this District to certify classes under multiple subsections of Rule 23(b). It makes abundant sense to do so in this case because the Court could immediately grant injunctive relief under the Rule 23(b)(2) class (without the need for class notice, etc.), and then proceed with the normal notice procedures for purposes of awarding damage.

B. Class Treatment is Proper under Rule 23(b)(1)

Defendants' arguments against certification under Rule 23(b)(1) are likewise unpersuasive. Plaintiffs do not argue about the possibility that recoveries may vary between plaintiffs, but rather that inconsistent adjudications could establish uncertainty through incompatible standards of conduct for Defendants. Moreover, as explained above, the Rule 23(b)(1) certification would be limited to injunctive relief, so all of the Defendants' arguments regarding damages are beside the point.

IX. Class Treatment is Proper Under Rule 23(a)

A. The Named Plaintiffs are Adequate Class Representatives and Do Not have Conflicts with the Class they Seek to Represent.

As the Court stated in *Freeland v. AT & T Corp*, 238 F.R.D. 130 (S.D.N.Y. 2006), a conflict that will prevent a plaintiff from meeting the Rule 23(a)(4) adequacy prerequisite "must be fundamental, and speculative conflict should be disregarded at the class certification stage." *Id.* at 141. Rule 23(a)(4) "is designed to ferret out potential conflicts *between representatives and other class members*." *Id.* at 142. Accordingly, "the focus, then, should be on the ways in which the interest of the named plaintiffs in this case is antagonistic to the interests of other class members." *Id.*

Defendants fail to raise any conflict or antagonistic interests between the class representatives and the class they seek to represent. Instead, Defendants raise purported intra-class conflicts unrelated to the class representatives, which are speculative and in no way render the representatives inadequate. First, Defendants suggest that several class members might assert a claim associated with the same mark. As an initial matter, even if true, this is not an issue related to the adequacy of the class representatives. Instead, Defendants are making the illogical argument that because their wide ranging Deceptive Domain Scheme may have actually damaged more than one party with respect to the same mark they should be effectively sheltered and insulated from resulting liability. If Defendants have injured more than one party with a particular Deceptive Domain, the proper course is to allocate the damages between and among the injured parties at the damage allocation stage – not to deny class certification. Moreover, this argument does not even apply to the doubly-registered subclass, because that subclass is limited to only those mark owners that have registered their marks as (or within) domain names. While fifty entities may register the same mark with respect to varying goods and services, only one of those fifty can register the mark as a domain name (or a particular domain name containing the mark) within each top-level domain (.com, .net, etc.). Once it is taken, it is gone.

Second, Defendants claim that current and former AdWords participants may have divergent financial interests related to the ongoing success of the Google advertising program. This type of speculative argument is routinely rejected. *See, e.g., In re Honeywell Intern. Inc. Securities Litig.,* 211 F.R.D. 255 (D.N.J. 2002) (rejecting the defendant's Rule 23(a)(4) adequacy argument that plaintiffs, who no longer retain any interest in the company, have an incentive simply to obtain the largest possible recovery, while those who retain their interest have an incentive to maximize the combined value of their recovery and the stock that they retain); *Walsh v. Chittenden Corp.*, 798 F. Supp. 1043 (D. Vt. 1992) (holding that stock purchaser's continued ownership of shares that were the subject of the securities fraud lawsuit did not create a conflict of interest with class members who no longer owned stock, and thus did not preclude the purchaser from serving as a class representative); 3B Moore's Federal Practice ¶ 23.06-2 at 23-182 (2d ed. 1993 & Supp. 1994) (citing cases) (a court is not authorized to dismiss a class action based upon a substantial legal claim merely because some members of the class prefer to leave the violation of their rights unremedied). In sum, Defendants have not raised any conflicts between the class representatives and the putative class that would render them inadequate under Rule 23(a)(4).

B. The Named Plaintiffs are Typical Class Representatives.

The typicality requirement requires a district court to focus on whether the named plaintiffs' claims have the same essential characteristics as the claims of the class at large. Defendants have not disputed that courts within the Seventh Circuit have consistently applied the juridical link doctrine to class actions finding that named plaintiffs are not required to have direct contact with each of the named defendants to bring their claims on behalf of a proposed class. *Id.*; *Weiss v. Winners Circle*, 1995 WL 755328 (N.D. Ill. 1995); *Contact Buyers League v. F. &*

F. Investment, 300 F. Supp. 210 (N. D. Ill. 1969). As such, Defendants, reliance upon *Weld v. Glaxo Wellcome Inc.,* 746 N.E.2d 522 (Mass. 2001) is puzzling and evidences the weakness of their argument. Contrary to Defendants' argument, the *Weld* court actually held, under the juridical link doctrine, that the class representative's lack of contact with some of the defendants did not render the representative's claims atypical under Rule 23(a)(3). *Id.* at 530. Likewise, here, Plaintiffs' claims all arise from the Defendants' concerted effort to implement and monetize the Deceptive Domain Scheme and therefore the class representatives' claims are typical under Rule 23(a)(3) even if the representatives did not have direct contact with certain Defendants.

CONCLUSION

For the foregoing reasons, Plaintiffs respectfully request that this Court certify either the originally proposed Class or the proposed subclass or variation thereof as the Court may deem appropriate, and grant all further relief requested in Plaintiffs' Motion for Class Certification.

Dated: September 25, 2008 FOOTE, MEYERS, MIELKE & FLOWERS, LLC

By: /s/ Robert M. Foote

Robert M. Foote, Esq.
Craig S. Mielke, Esq.
Matthew J. Herman, Esq.
Stephen W. Fung, Esq.
Mark A. Bulgarelli, Esq.
Foote, Meyers, Mielke & Flowers, LLC
28 North First St., Suite 2
Geneva, IL 60134
Tel. No.: (630) 232-6333

Kathleen C. Chavez, Esq.
Chavez Law Firm, P.C.
28 North First St., Suite 2
Geneva, IL 60134

William J. Harte, Esq.

Dana Pesha, Esq.
William J. Harte, Ltd.
111 West Washington Street, Suite 1100
Chicago, IL 60602

Benjamin G. Edelman, Esq.
Law Office of Benjamin Edelman
27a Linnaean Street
Cambridge, MA 02138
Tel. No.: (617) 359-3360

Bryan L. Clobes, Esq.
Cafferty Faucher, LLP
1717 Arch Street
Suite 3610
Philadelphia, PA 19103

Nyran Rose Pearson, Esq.
Dom J. Rizzi, Esq.
Cafferty Faucher LLP
30 North LaSalle Street
Suite 3200
Chicago, IL 60602

Attorneys for Plaintiffs

CERTIFICATE OF SERVICE

I hereby certify that on September 25, 2008, I electronically filed the foregoing document with the clerk of court for the U. S. District Court, Northern District of Illinois, using the electronic case filing system of the court. The electronic case filing system sent a "Notice of Electronic Filing" to the following attorneys of record who have consented in writing to accept this Notice as service of this document by electronic means:

Brett A. August
baugust@pattishall.com

Michael H. Page
mhp@kvn.com

Mariah Moran
mmoran@stetlerandduffy.com
edocket@stetlerandduffy.com

Janelle M. Carter
jcarter@winston.com
ECF_CH@winston.com

Alison Conlon
conlon@wildmanharrold.com
ecf-filings@wildmanharrold.com
hardt@wildmanharrold.com

Joseph Gratz
jgratz@kvn.com

Alexis Payne
aep@pattishall.com

Jeffrey Singer
jsinger@smsm.com

Anastasios Foukas
afoukas@smsm.com

Michael R. Dockterman
dockterman@wildmanharrold.com
ecf-filings@wildmanharrold.com
eckertm@wildmanharrold.com

Kenneth P. Held
kheld@velaw.com

Steven Borgman
sborgman@velaw.com
jwarren@velaw.com
steveborgman@gmail.com
yshumaker@velaw.com

Bradley L. Cohn
bcohn@pattishall.com

Jonathan M. Cyrluk
cyrluk@stetlerandduffy.com
edocket@stetlerandduffy.com

Misty Martin
mmartin@smsm.com

Ronald Rothstein
rrothsstein@winston.com
ECF_CH@winston.com
mconroy@winston.com

Scott R. Wiehle
swiehle@velaw.com

Joseph Duffy
jduffy@stetlerandduffy.com
bdorgan@stetlerandduffy.com
edocket@stetlerandduffy.com

William J. Harte
wharte@williamharteltd.com
mccarey@williamharteltd.com

Dana Marie Pesha
dpesha@williamharteltd.com
mccarey@williamharteltd.com

Scott Ryan Wiehle
swiehle@velaw.com

Aaron Van Oort
mavanoort@faegre.com

I certify that I have served the foregoing document by emailing a copy to the following individuals:

Steven Atlee
SAtlee@winston.com

Vincent V. Carissimi
carissimiv@pepperlaw.com

Joanna J. Cline
clinej@pepperlaw.com

Robert J. Hickok
hickokr@pepperlaw.com

R. Adam Lauridsen
alauridsen@kvn.com

Daralyn J. Durie
ddurie@kvn.com

/s/Robert M. Foote